

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN TOBAKO

Appeal No. 2004-0299
Application No. 09/932,543

ON BRIEF

Before GARRIS, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-20 which are all of the claims in the application.

The subject matter on appeal relates to a hand tool. With reference to the appellant's drawing, the hand tool comprises a shank 12 having an elongated groove 20, a slidable sleeve 40 having an internal channel 42 which receives the shank and having

a set aperture 44 as well as proximal and distal snap holes 50 and 52, a set 70 disposed in the set aperture and positioned to bias into the elongated groove wherein the set prevents sliding between the shank and sleeve when tightened and allows sliding between the shank and sleeve when loosened, and a selective lock 28 comprising a bore 30 housing a spring 32 and ball 34 for engagement into snap holes 50 and 52. This appealed subject matter is adequately represented by independent claims 1 and 9 which read as follows:

1. A hand tool, comprising:

a shank integrally joined to an operational head at the proximal end of the shank, the shank including an elongated groove with corresponding ends adjacent the proximal and distal ends of the shank;

a slidable sleeve having an internal channel, the sleeve sized to receive the shank, the sleeve defining a set aperture, a proximal end portion of the sleeve defining a proximal snap hole, and a distal end portion of the sleeve defining distal snap hole;

a set disposed in the set aperture and positioned to bias into the elongated groove, the set preventing sliding between the shank and sleeve when tightened and the set allowing sliding between the shank and the sleeve when loosened; and

a bore defined adjacent a distal end of the shank, the bore housing a spring and a ball, the spring directing the ball into the proximal snap hole when the sleeve is fully extended from the shank, the spring directing the ball into the distal snap hole when the sleeve is fully contracted relative to the shank.

9. A hand tool, comprising:

a shank having a proximal end joined to an operational head, the shank including an elongated groove;

a slidable sleeve having an internal channel, the sleeve sized to receive the shank, the sleeve defining a set aperture;

a set disposed in the set aperture and positioned to bias into the elongated groove, the set preventing sliding between the shank and sleeve when tightened and the set allowing sliding between the shank and the sleeve when loosened; and

a selective lock relating between the sleeve and the shank, the lock preventing separation of the sleeve and the shank when the sleeve and shank are in rotational alignment, the lock allowing separation of the sleeve and the shank when the sleeve and shank are out of rotational alignment.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Prichard	2,869,410	Jan. 20, 1959
Tremblay	3,227,015	Jan. 4, 1966
Raber	5,109,737	May 5, 1992

Claims 1-3, 5, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tremblay; claim 6 stands correspondingly rejected over Tremblay in view of Prichard; claims 4, 9-13 and 15-20 stand correspondingly rejected over Tremblay in view of Raber; and claim 14 stands correspondingly rejected over Tremblay in view of Raber and further in view of Prichard.¹

¹ On page 3 of the brief, the appellant has grouped claims
(continued...)

We refer to the brief and reply brief and to the answer for a detailed exposition of the contrary viewpoints expressed by the appellant and by the examiner concerning the above noted rejections.

OPINION

For the reasons which follow, we will sustain the section 103 rejections of claims 1-8 but not the section 103 rejections of claims 9-20.

The only claim 1 distinction which has been argued by the appellant with any reasonable specificity concerns the recitation "the set preventing sliding between the shank and sleeve when tightened." It is the examiner's view that screw 30 of patentee's Figure 1 tool embodiment inherently would be capable of engagement with the bottom of groove 32 to thereby prevent sliding between shank 16 and sleeve or body 10 as recited in

¹(...continued)

1-8 separately from claims 9-20. Consistent with this claim grouping, the appellant has not contested the separate rejections of claims 6 and 14 respectively. Indeed, the arguments in the brief and reply brief are concerned with independent claims 1 and 9 only. It follows that, in assessing the merits of the rejections before us, we will restrict our focus to only these independent claims. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) and compare In re McDaniel, 293 F.3d 1379, 1382-85, 63 USPQ2d 1462, 1464-66 (Fed. Cir. 2002).

appealed claim 1. The appellant's opposing viewpoint is expressed on page 3 of the reply brief in the following manner:

It is not "inherent" that the set screw of Trembly [sic, Tremblay] engages the bottom of the groove. If Trembly's [sic, Tremblay's] set screw did so engage, it would interfere with the operation of the detents. Fixed point securement along the length of Trembly's [sic, Tremblay's] groove is performed by the detent, not the set screw. The screw engages the edge [i.e., shoulder 32a] of the groove, not the bottom.

We appreciate that the mode of operation disclosed by Tremblay for his Figure 1 tool embodiment does not include engagement of screw 30 with the bottom of groove 32. However, this fact does not forestall a determination that patentee's tool structure would be inherently capable of such engagement. See In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973) and In re Glass, 474 F.2d 1015, 1019, 176 USPQ 529, 532 (CCPA 1973). The pivotal issue is whether the Tremblay structure inherently possesses the capability of performing the previously quoted function claimed by the appellant (id.) based upon a determination which is reasonably supported by fact and/or technical reasoning (see Ex parte Levy, 17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int.) and Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986)). We share the examiner's view that the answer to this issue is in the affirmative.

In this latter regard, we point out that, as illustrated in Figure 1 of Tremblay, patentee's screw 30 possesses no head or any other structural feature which would prevent the screw from spiraling down into the threaded aperture therefor. Thus, the only structural feature of Tremblay's Figure 1 tool which would limit this downward movement would be engagement of the lower section of screw 30 with the bottom (or longitudinal sides) of groove 32. Such engagement would necessarily prevent sliding between patentee's shank 16 and sleeve or body 10 in accordance with the claim 1 recitation under consideration.

Under the circumstances set forth above and in the answer, it is our ultimate determination that the examiner has established a prima facie case of unpatentability for independent claim 1 based on the Tremblay reference which the appellant has failed to successfully rebut with argument and/or evidence of patentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We hereby sustain, therefore, the examiner's section 103 rejection of claims 1-3, 5, 7 and 8 as being unpatentable over Tremblay. We also hereby sustain the corresponding rejections of claim 6 based on Tremblay in view of

Prichard and of claim 4 based on Tremblay in view of Raber² since these rejections have not been contested by the appellant in the brief or reply brief.

We reach a different determination concerning the examiner's rejection of appealed independent claim 9. According to the examiner, "[i]t would have been obvious to one having ordinary skill in the art to form the device of Tremblay such that the snap hole and bore may be . . . rotationally offset to facilitate adjustment or removal of the sleeve as taught by Raber [i.e., to thereby obtain the end versus out of rotational alignment feature recited in claim 9]" (answer, page 6). The examiner's obviousness conclusion is not well taken.

This is because the rotational feature recited in claim 9 and disclosed in Raber is not compatible with the tool of Tremblay. In order to effect the functionally necessary rotation of socket 18, Tremblay's shank 16 and sleeve or body 10 must be rotationally fixed with respect to one another. It follows that the tool would be incapable of operating in the manner disclosed

² It is appropriate to point out that Raber is unnecessary with respect to the rejection of claim 4 given the undisputed interpretation of the claim 4 phrase "laterally offset" expressed by the examiner in the last full paragraph on page 6 of the answer.

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by Tremblay if it were provided with the rotational feature proposed by the examiner.

For this reason, we cannot sustain the examiner's section 103 rejection of claims 9-13 and 15-20 as being unpatentable over Tremblay in view of Raber or the corresponding rejection of claim 14 as being unpatentable over these references and further in view of Prichard.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Bradley R. Garris)	
Administrative Patent Judge)	
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Catherine Timm)	BOARD OF PATENT
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